

REMARKS

The applicants have responded to the restriction requirements by amending the claims so that they now have a unified use. The examiner found that claims define three different invention:

- I) claims 1-6 are drawn to a coin;
- II) claims 7-10 are drawn to an optical sensor/reader; and
- III) claims 11-15 are drawn to a method of etching a substrate.

Paragraph 2 of the Office Action states that Inventions I and II “are distinct from each other if they are shown to be separately usable...and that invention II has separate utility such as a sensor/reader for an optical identification card.” The applicants have amended claims 7 and 9 to limit the use of the coin tester to testing coins, and exclude the testing of optical identification cards. Therefore, the subcombinations of Inventions I and II are not distinct from each other.

Paragraph 3 of the Office Action states that Inventions I and III “are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process...[Invention] I could be made by using an alternate etching means, such as chemical, and...[Invention] III could be used to produce an alternate optical record, such as an identification card.” The applicants have amended the claims so that the method claims are

drawn specifically to a method of applying a microscopic relief structure to a coin. Therefore, the subcombinations of Inventions I and III are not distinct from each other.

Paragraph 4 of the Office Action states that Inventions II and III “are distinct from each other if they are shown to be separately usable...[and] invention III has separate utility such as etching a code on an identification card.” The amended claims now limit the method to a method of applying a microscopic relief structure to a coin and exclude the use of the method for etching a code on an identification card. Therefore, the subcombinations of Inventions I and III are not distinct from each other.

In paragraph 8 of the Office Action, claims 5 and 6 have been found to be improperly multiple dependent claims. Applicants amended these claims to remove the multiple dependencies in the Preliminary Amendment which was filed with the application. Amended claims 5 and 6 depend only on claim 1 and are not multiple dependent claims. Accordingly, applicants request that the objection to these claims be withdrawn.

The applicants submit that the amendments to the claims have overcome the bases for finding that a restriction was proper and that the present application included more than one invention. At the very least, Inventions I and II are not distinct since they are drawn to a coin and an optical sensor/reader for testing such a coin. Accordingly, the applicants respectfully request that the restriction requirement be withdrawn or, in the alternative, that the applicants be allowed to prosecute Inventions I and II in the present application.

Application Serial No.: 09/936,935
Amendment in Response to 1/27/04 Office Action

Docket No.: 1093-36PCT/US

In the event that the Examiner finds that restriction is proper after considering the amendments to the claims and the applicants' arguments, the applicants elect to prosecute Invention I (claims 1-6) in the present application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Kevin E. McDermott", with a long horizontal flourish extending to the right.

Kevin E. McDermott
Registration No.: 35,946
Attorney for Applicants

HOFFMANN & BARON, LLP
6900 Jericho Turnpike
Syosset, New York 11791
(516) 822-3550

184131_1